

**REMARKS**

By the present amendment, Applicant has amended Claim 1. Claims 1-19 remain pending in the present application. Claims 1 and 8 are independent claims.

Pursuant to the recent telephonic Restriction Requirement under 35 U.S.C. §121 between Invention I (Claims 8-19) and Invention II (Claims 1-7), Applicant provisionally elected with traverse for further prosecution the apparatus defined by Claims 1-7 (Group II). Notwithstanding the propriety of the requirement for examination purposes, Applicant contends that he should be entitled to a consideration of a limited number of related embodiments falling within the scope of a generic concept. It is respectfully noted that the method of Group I can not necessarily be accomplished without the apparatus of Group II. Moreover, it would appear that a search and examination of the entire application could be accomplished without a serious burden on the Office since both embodiments identified of record would seemingly encompass a common field of search. Therefore, it is respectfully requested that the Examiner withdraw the restriction requirement and issue an action on the merits of the method defined in Claims 8-19

The claims in this application have been revised to more particularly define Applicant's unique construction in view of the prior art of record. Reconsideration of the claims in light of the amendments and for the following reasons is respectfully requested.

In the recent Office Action, the Examiner rejected Claims 1 and 2 under 35 U.S.C. §103(a) as being unpatentable over Farrell, Jr. (4,253,813). Further, Claims 1, 3, 4 and 7 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Fraser (4,415,269). Additionally, Claims 2 and 5 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Fraser in view of Farrell, Jr. Further, Claim 6 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Fraser.

Applicant will advance arguments hereinbelow to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

The system of the subject Patent Application is directed towards an apparatus for masonry chimney flue repair. As shown in Figs. 1 and 2 of the subject Patent Application, applicator 10 is positioned within flue F and mortar M is poured into flue F, over the applicator 10. Applicator 10 includes a vibrator 22, mounted within a foam core, which defines an exterior surface and is coated with an elastomer coating 18. As best shown in Fig. 1, the mortar M is poured over the exterior surface of the applicator 10, and when the applicator 10 is drawn through the flue F, the mortar M is diverted to coat the walls of the flue F. Selective vibration caused by vibrator 22 causes the entire apparatus 10, particularly the exterior surface, to vibrate, which urges the mortar into discontinuities D, under mechanical force.

The Farrell, Jr. reference is directed towards an apparatus for applying a flowable coating material to the interior of a stack. Although the Farrell, Jr. reference teaches a foam applicator, the applicator does not include any sort of vibrational means. The Farrell, Jr. reference does not teach or suggest the combination of a vibrator with the applicator, which is necessary for the urging of mortar into the discontinuities of a flue wall.

Similarly, the Fraser reference is directed towards a device for providing a reinforced foam lining for well bore holes, but the Fraser reference does not teach or suggest the usage of a vibrator within the applicator. With regard to Claim 3 in the outstanding Office Action, the Examiner contends "... including an electrical power 3 that could *capable (sic)* of vibrating when the power turned on (*sic*) and it disposed (*sic*) within said applicator ..." (emphasis added). It appears that the Examiner is stating that electrical motor 3 acts as a vibrator, as if vibration is inherent in a motor.

The Fraser reference does not teach or even suggest the type of motor used in the system, thus any characterization, including whether the motor vibrates or not, is pure speculation on the part of the Examiner. The Fraser reference makes no mention at all of a vibrating applicator, nor is vibration within the apparatus even suggested. Further, the positioning of the motor 3 within the system (the separation of motor 3 from the outer housing is clearly shown in Fig. 1) makes it highly unlikely that, even if the motor 3 vibrated, it would have any vibrational effect on the exterior of the apparatus.

With regard to inherency in terms of obviousness, under 35 U.S.C. 103, obviousness analysis is based upon the person of ordinary skill in the art. This knowledge is measured at the time the invention is made. Hindsight reconstruction of the invention, looking back at the prior art to second-guess the inventor once the invention is available, is anathema to an obviousness assessment. Inherency, however, is based on such hindsight. It is a recognition today that an invention was present in the prior art, even though it was not understood to be there at the time. In the present case, the Examiner is using hindsight to speculate that the motor 3 “could” be capable of producing vibration, although it is clearly not provided for such a purpose (nor is there any indication that the motor has any vibrational characteristics at all). Thus, it is believed that the Examiner’s determination that the vibrator is made obvious through the speculative possibility of inherency in the Fraser system is highly flawed under well-established principles of U.S. Patent Law.

Thus, neither the Farrell, Jr. reference nor the Fraser reference, when taken alone or in combination, provide for: “... an electrically powered vibrator disposed within said applicator for tamping the mortar material firmly into the irregularities within the flue liner, said electrically powered vibrator selectively causing an exterior surface of said applicator to vibrate, whereby the mortar material flowing over said exterior surface is driven by the selectively vibrating exterior surface into the irregularities within the flue liner ...”, as is clearly provided by newly-amended independent Claim 1.

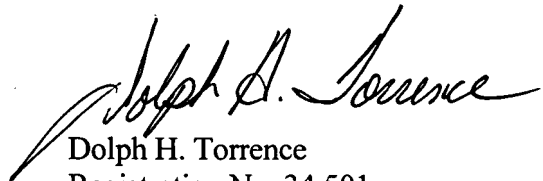
Thus, it is believed that the subject Patent Application is not made obvious by the Farrell, Jr. reference or the Fraser reference, when taken alone or in combination, when independent Claim 1 is carefully reviewed.

It is now believed that the remaining pending Claims 2-7 show patentable distinction over the prior art cited by the Examiner for at least the same reasons as those given above with respect to Claim 1.

The remaining references cited by the Examiner but not used in the rejection have been reviewed, but are believed to be further removed when patentable distinctions are taken into account than those cited by the Examiner in the rejection.

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,

  
Dolph H. Torrence  
Registration No. 34,501  
(703) 486-1000

DHT:mdr

Attachments: Request for Extension of Time for One Month and fee